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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,750	12/21/2001	Masanori Aritomi	35.C16049	5081

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EXAMINER

RUDOLPH, VINCENT M

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/023,750	Applicant(s) ARITOMI, MASANORI	
	Examiner Vincent Rudolph	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 12-31 are rejected under 35 U.S.C. 102(b) as being unpatentable by Hicks ('353).

Regarding claim 9, Hicks ('353) discloses a printing control method having a first display step of using a touch screen with a user interface on it (See Figure 1, Element 100), so when the "Transparencies" button is selected (See Figure 2), it initializes the presentation and supporting sets, which includes a distribution, or handout set according to Hicks ('353) (See Figure 3 under the "Transparencies" and "Handout Set(s)" columns; Col. 7, Line 7-10). A second display step is used for displaying a tab for the quantity of additional sheets with each set and the sequential order the user wants to output them (See Figure 3 under the "Sequence" column; Col. 9, Line 58-60), as well as a third step for selecting the color scheme for each handout set, such as monochrome (black and white), full color, custom color, etc. (See Figure 3 under the "Handout Set(s)" column; Col. 7, Line 64-67). Once the user makes all the modifications needed, an issue step is sent out for a print request to be ordered (See

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Col. 10, Line 14-16) for the sets and printed in the sequence and quantity specified (See Col. 9, Line 58-60), including the colors the user specified for the presentation and distribution material in the third display step (See Figure 3 under the "Transparencies" column; Col. 7, Line 42-47). Note that option to print the presentation material (Transparencies) in color is irrespective whether the distribution material (handout sets) are printed in monochrome or color.

Regarding claim 12, Hicks ('353) discloses having the printing information generation apparatus, which was described as a printing apparatus, be able to insert instruction information of the same data for a plural of different printing finishing processes (See Figure 3), or print out the transparency and any supporting sets according to Hicks ('353) in any particular order (See Col. 7, Line 28-30), within the same printing job (See Figure 4; Col. 8, Line 47-59).

Regarding claim 13, Hicks ('353) discloses the printing apparatus having the capability to simultaneously setting the instruction information for the presentation and any supporting set prior to printing them (See Figure 3).

Regarding claim 14, Hicks ('353) discloses the ability to execute setting a color change process for the printing information and inserting it into the selected set in accordance with the process by the printing process settings with each set (See Figure 3 under "Transparencies", "Dividers", "Master Set", and "Handout Set(s)") before printing them out (See Col. 7, Line 42-67).

Regarding claim 15, Hicks ('353) discloses within Figure 3 that the plural different finishing processes involves the printing of the presentation, or transparency, set and each of the distribution, or supporting, sets (See Col. 7, Line 42-67)

Regarding claim 20, Hicks ('353) discloses a printing control system, which is described as a printing apparatus, having a host apparatus, which is a touch screen monitor described by Hicks ('353) (See Figure 1, Element 100), that can allow the user to view the document set and generate the information for printing it (See Col. 10, Line 1-6) and transmitting it onto a printing/copying machine that receives the job from the touch screen display (See Figure 7, Element 12 and 14; Col. 4, Line 16-20). The host apparatus is also able to insert information regarding the plural different printing sets, such as various colors, additional sheets, markers, editing the figures, etc. (See Figure 3 and 4; Col. 8, Line 47-Col. 9, Line 5). Once the printing apparatus receives the job request, it collectively outputs the job in the sequence, quantity, and specification requested (See Figure 3; Col. 8, Line 52-59).

Regarding claim 28, Hicks ('353) discloses having an image processing system (See Figure 7, Element 12) that controls electronics to prepare and manage the image data (See Col. 4, Line 8-9) and is in communication with the user interface (See Figure 7, Element 14) to inputs saved jobs from a memory card (See Figure 1, Element 102) or stored within the resident memory (See Col. 10, Line 49-52). Even though Hicks ('353) does not disclose having a medium to provide the user interface program, it is inherent that in order to have a user interface program to execute certain commands, a memory is needed for storing the program. Then user interface is used to insert instruction

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information regarding the all the plural printing processes using the same data within one print job (See Figure 3; Col. 8, Line 47-59) and can also edit, modify, and output the printing information sets according to the user's specification (See Col. 7, Line 27-30; 10, Line 1-6), such as the sequence and quantity requested (See Figure 3; Col. 9, Line 58-60).

Regarding claims 17-19, 21-23, 25-27, and 29-31, the rationale provided in the rejection of claims 13-15 is incorporated herein.

Regarding claims 16 and 24, the rationale provided in the rejection of claims 12 and 20 are incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks ('353).

Regarding claim 1, Hicks ('353) discloses having a printing control method with a mode selecting step to select the presentation, or transparencies, button (See Figure 2), which allows the user to open go into the presentation mode and be able to edit and modify the transparency, as well as the distribution handout sets and other supporting sets (See Figure 3; Col. 7, Line 7-10). Hicks ('353) also discloses a number of copies

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setting step within the transparencies tab. This step is needed so the user can also specify how many extra copies, or additional sheets, are needed for the distribution material (See Figure 3; Col. 7, Line 64-67). Once the requests are completed, an issue step is needed to have the job printed using the touch screen display (See Figure 1, Element 100; Col. 10, Line 1-6). Finally, a printing execution step is done to have the presentation material printed in the color specified by the user (See Figure 3) onto one recording paper (See Figure 4) and the distribution, or supporting set, material printed in the color also predetermined by the user (See Figure 3; Col. 7, Line 42-67).

Hicks ('353) does not disclose though a method to have a selected amount of multiple distribution handout pages printed onto one paper.

Sagman discloses within Microsoft Power Point, a user can select a predetermined number of pages to be put onto one recording paper and distribute it as a handout.

It would have been obvious to one skilled in the art at the time of invention by the applicant to have the method described by Sagman and incorporate it into the multi-function printing apparatus of Hicks ('353). By adding the feature of multiple slides per page, it can eliminate the need to edit, resize or modify images and instead allows people enough room to make notes for each slide on the handouts.

Thus, claim 1 is properly rejected under 35 U.S.C. 103(a).

Regarding claim 2, Hicks ('353) discloses having the user select the color to be printed onto the transparency, such as full color, monochrome (black and white), etc. (See Figure 3; Col. 7, Line 43-47).

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Regarding claim 3, Hicks ('353) discloses a method for a page number setting step and be able to print the specified quantity of the distribution material from the printing step (See Figure 3; Col. 7, Line 65-67).

Hicks ('353) does not disclose though a method to have a page number setting step and have the user predetermine a select number of pages to be put onto one recording paper of the distribution material.

Sagman discloses within Microsoft Power Point, a user can select a predetermined number of pages, such as 2, 3, or 6 slides, to be put onto one recording paper and distribute it as a handout.

It would have been obvious to one skilled in the art at the time of invention by the applicant to have the method described by Sagman and incorporate it into the multi-function printing apparatus of Hicks ('353). By adding a predetermined number of pages to print out onto one recording paper, it gives people room to put notes down for each slide of the distribution material.

Thus, claim 3 is properly rejected under 35 U.S.C. 103(a).

Regarding claim 4, Hicks ('353) discloses the printing job can have a specified amount of only distribution (handout or master set according to Hicks ('353)) material stapled together (See Col. 10, Line 19-22) because the presentation material is shown one-by-one on a projector, it cannot be stapled together.

Regarding claim 5, the rationale provided in the rejection of claim 1 is incorporated herein. In addition, Hicks ('353) discloses having a color mode selection step for the distribution mode, or handout set (See Figure 3), where the user can specify

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the color to print the distribution material in, such as color, monochrome, etc. (See Col. 7, Line 65-67).

Regarding claim 10, Hicks ('353) discloses having a printing information generation apparatus, which is a printing apparatus described by Hicks ('353), which includes an input unit on a touch screen display (See Figure 1, Element 100) to recall a job using a memory card slot (See Figure 1, Element 102) or from the resident memory stored within the printing apparatus (See Figure 6; Col. 10, Line 49-56). Then a judgment unit, or stored jobs display (See Figure 6), is used to recall jobs from the input unit and tell if it includes presentation and distribution material along with their saved instructions (See Col. 10, Line 49-57). An image data generation unit, or printer according to Hicks ('353) (See Figure 1), outputs the job data with the saved specifications of the presentation and distribution material, such as each ones color, quantity (See Col. 8, Line 1-5; Col. 9, Line 58-60).

Hicks ('353) does not disclose though a method to have a selected amount of multiple distribution handout pages printed onto one paper.

Sagman discloses within Microsoft Power Point, a user can select a predetermined number of pages to be put onto one recording paper and distribute it as a handout.

It would have been obvious to one skilled in the art at the time of invention by the applicant to have the method described by Sagman and incorporate it into the multi-function printing apparatus of Hicks ('353). By adding the feature of multiple slides per

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page, it can eliminate the need to edit, resize or modify images and instead allows people enough room to make notes for each slide on the handouts.

Thus, claim 10 is properly rejected under 35 U.S.C. 103(a).

Regarding claim 11, Hicks ('353) discloses the image data generation unit, or printer according to Hicks ('353) (See Figure 1), generates the distribution material, or handout set, on the basis of the data from the input unit (See Col. 10, Line 52-56) with the image data color specified by the user (See Col. 7, Line 65-67).

Hicks ('353) does not disclose a way to have the number of pages to be recorded onto one page of the distribution material included within the printing job data.

Sagman discloses within Microsoft Power Point, a user can choose a select number of pages, such as 2, 3, or 6 slides, to be put onto one recording paper and distribute it as a handout, which is included in the printing job data prior to outputting.

It would have been obvious to one skilled in the art at the time of invention by the applicant to have the method described by Sagman and incorporate it into the printing information generation apparatus of Hicks ('353). By adding a select number of pages included in the printing job prior to outputting it onto one recording paper, it allows individuals enough space to put notes down for each slide of the distribution material.

Thus, claim 11 is properly rejected under 35 U.S.C. 103(a).

Regarding claims 6-8, the rationale provided in the rejection of claims 2-4 is incorporated herein.

Conclusion

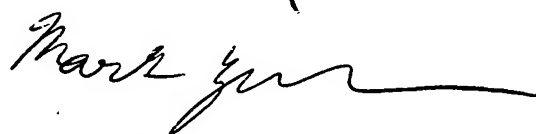
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tonkin ('702).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vincent Rudolph
Examiner
Art Unit 2624



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SUPERVISORY PATENT EXAMINER
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